

## **REMARKS**

Claims 1-5, 7-17, 19-30, 32-46 and 48-59 are pending. Claims 1, 7, 23, 32, 38, 48, 55, 56 and 58 are amended. These amendments find basis at paragraph 0091 on page 5, and in original claims 6, 31 and 47. Claim 59 is added and finds basis in original claim 1, paragraph 0005 on page 2, paragraph 0016 on page 4, and paragraph 0021 on page 6. Claims 6, 18, 31 and 47 are canceled.

### **Double Patenting**

Claims 1-58 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-14 of copending Application No. 10/720,563. Because the scope of any allowed claims is not known at present, Applicants believe that it is premature to fully evaluate this rejection and it is best handled after allowable subject matter is determined.

### **Rejections Under 35 U.S.C. §102**

Claims 1-58 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Published Application No. 2007/0128440 (“the 440 publication”). This rejection seems to be in error as the 440 publication is the published application corresponding to the instant application. Withdrawal of the rejection is respectfully requested.

Claims 1-5, 8, 10 and 23 were rejected under 35 U.S.C. §102(e) as anticipated by WO 2004/039893 (“the 893 application”). The Office presents U.S. Published Application No. 2006/0052509 as a translation of the 893 application. The rejection is moot in view of the amendment of claim 1 to contain matter from claim 6 and the amendment of claim 23 to incorporate matter from claim 31. Neither claim 6 nor claim 31 is subject to the rejection.

Claims 1, 23, 38-40, and 42-43 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Published Application No. 2004/0023372 (“the 372 application”). The rejection is moot in view of the amendment of claim 1 to contain matter from claim 6, the amendment of claim 23 to incorporate matter from claim 31, and the amendment of claim 38 to incorporate matter from claim 47. None of claims 6, 31 and 47 are subject to the rejection.

### **Rejections Under 35 U.S.C. §103**

Claims 1-5, 8-10, 23-46 and 49-58 were rejected under 35 U.S.C. §103(a) as allegedly obvious over the 893 application in view of the 372 application. The rejection is moot in view of the amendment of claim 1 to contain matter from claim 6, the amendment of claim 23 to incorporate matter from claim 31, and the amendment of claim 38 to incorporate matter from claim 47. None of claims 6, 31 and 47 are subject to the rejection. Analogous amendments were made to claims 55, 56 and 58. Withdrawal of the rejection is respectfully requested.

Claims 6, 7, 47 and 48 were rejected under 35 U.S.C. §103(a) as allegedly obvious over the 893 application in view of the 372 application and further in view of U.S. published application No. 2005/0069947 (“the 947 application”). To establish a *prima facie* case of obviousness, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Moreover, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The reason to make the claimed combination, and a reasonable expectation of success, must be found elsewhere than in Applicants disclosure, such as in the prior art, the nature of the problem to be solved, or in the knowledge/understanding of the person of ordinary skill in the art. MPEP § 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants submit that the instant rejection does not meet these requirements.

The pending claims are directed to probing tools comprising a nanotube at least partially coated with a biocompatible silica coating capable of absorbing a bioreactive molecule and methods utilizing such probes. The probes additionally contain a marking enzyme. There is a need in the art for methods of researching disease or injury processes or chemical interaction processes in which the ability to modify the interior of a cell without damaging the cell membrane is important. The instant claims are directed to this important goal. The probes of the instant invention allow for testing of proprietary compounds more efficiently than methods known in the art. See, paragraphs 0001-0003 spanning pages 1-2 and paragraphs 0015-0017 spanning pages 3-4.

The instant claims require a coating of biocompatible silica on the carbon nanotube. Of the cited references, silica is only mentioned in the 509 application. The mention in the 509 application, however, is as an optional ingredient. See, for example, paragraph 0012 and the Abstract of the 509 application. At most the 509 application and the 372 application teach a carbon nanotube with an optional silica coating. The Examiner further cites the 947 application to provide the enzyme element of the claims. The 947 application teaches carbon nanotube compositions having an antibody attached to the nanotube (paragraph 0009 and the Abstract of the 947 application). The 947 application teaches a variety of optional elements such as detectable markers (paragraph 0136 of the 947 application). These detectable markers may optionally involve the use of an enzyme (*Id.*). As such, in order to arrive at any instantly claimed invention, one must select the optional colloidal silica element of the 509 application and the optional marker (and the enzyme from within that group—an option within an option) to combine with the basic carbon nanotube structure. Applicants submit that, absent Applicant's blueprint, there is not sufficient motivation to make the proposed combination of elements. The extent of reconstruction is contrary to the notion of obviousness. Withdrawal of the rejection is respectfully requested.

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**PATENT**

**Closing**

The foregoing is believed to constitute a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Respectfully submitted,

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